

BEST AVAILABLE COPY**REMARKS**

Applicant has carefully considered the Final Office Action of October 31, 2005 and offers the following remarks in response thereto.

Claims 1-39 were rejected under 35 U.S.C. § 103 as being unpatentable over Strathmeyer et al. (hereinafter "Strathmeyer") in view of Takemoto et al. (hereinafter "Takemoto"). Applicant respectfully traverses. To combine references in an obviousness rejection, the Patent Office must do two things. First, the Patent Office must state a motivation to combine the references, and second, the Patent Office must support the stated motivation with actual evidence. *In re Dembiczaik*, 175 F.3d 994, 999 (Fed. Cir. 1999). Once a proper combination has been made, for the Patent Office to establish *prima facie* obviousness, the Patent Office must show where each and every element of the claims is taught or suggested. MPEP § 2143.03. If the combination must be modified to show the claimed invention, the Patent Office must show that there is a suggestion to modify the combination. *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992).

Applicant initially traverses the rejection because the Patent Office has not properly supported the motivation to combine the references. Specifically, the Patent Office asserts that the "benefits of using speed dial codes comprising abbreviated telephone number sequences include reduced keystrokes for faster dialing and reduced effort in memorizing numbers" (Office Action of October 31, 2005, page 3, lines 13-15) and that the motivation to combine the references is "to realize the above identified advantages." (Office Action of October 31, 2005, page 3, lines 17-18). The Patent Office has provided no evidence to support this asserted motivation. Since the Patent Office has not provided the required evidence, the motivation is improper. Since the motivation is improper, the combination is improper. Since the combination is improper, the rejection is improper and the claims are allowable.

Even if the combination is proper (a point which Applicant does not concede on this record), the combination of references does not establish obviousness. Specifically, the claims recite that the speed dial code is initially dialed from a PSTN-based telephony device and provides a specific definition of speed dial code. Strathmeyer teaches a PSTN-based telephony device 110 that uses the full telephone number. Takemoto teaches an IP based telephone 2 that uses a speed dial code from table 15 (see paragraph 0026, which indicates that Internet communication control apparatus 1 comprises two terminal interfaces 11 and 12 that are

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connected to telephone 2 and facsimile 3, which indicates that telephone 2 is an IP phone). Thus, when the references are combined, the PSTN-based telephony devices continue to use Strathmeyer's full telephone number, and the IP based telephony devices use the speed dial code of Takemoto. The combination does not teach the PSTN-based telephony devices using the speed dial code of Takemoto. Only if the combination is modified would the PSTN-based devices use the IP phone speed dial system. Thus, absent modification, the combination does not teach the claim element. Since the combination does not teach the claim element, the combination does not establish obviousness.

If the Patent Office asserts that it would be an obvious modification to modify the combination so that the PSTN-based devices use the IP phone speed dial system, the Patent Office must show that there is some suggestion to make this modification. It is worth noting that the motivation to make the modification is distinct from the motivation to make the combination and, therefore, separate proof is required. To date, the Patent Office has not provided any motivation to modify the combination or any proof of such a motivation. In the absence of such a stated motivation to modify the combination and accompanying appropriate proof, it is improper for the Patent Office to assert that the modification is obvious.

Applicant notes that the elements discussed above are present in each of the independent claims, and the Patent Office relies on the same analysis throughout its rejection. Thus, the arguments presented above are applicable to all the pending claims. Applicant requests withdrawal of the § 103 rejection of claims 1-39 at this time.

Applicant requests reconsideration of the rejection in light of the remarks presented herein. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

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